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Reg. No. 48,017

In re application of:
Menendez et al.

Serial No.: 09/698,502

Filed: October 27, 2000

For: Method for Completing and Storing an
Electronic Rental Agreement

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Examiner: Vig, Naresh

Group Art Unit: 3688

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief

In response to the Examiner's Answer dated May 17, 2012, Appellant submits the following as its Reply Brief in connection with the appeal of the above-referenced patent application.

I. The Examiner's Answer Fails to Properly Interpret and Apply the "Regardless Of" Language of Claims 62 and 113

Independent claim 62 recites:

wherein the electronically accepting, communicating, electronic rental contract creating and rental transaction storing steps are performed **regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental facility.**

At pages 17-18 of the Examiner's Answer in the "Response to Argument" section, the Examiner alleges:

In response to appellant's argument cited reference do not teach capability and concept wherein the claimed invention are performed regardless of whether the use has a pre-existing master rental agreement with a rental car company that operates the rental facility.

However, cited references teach capability and concept of the claimed invention. Also, applicant has not positively claimed to limit the use of invention by only the users who do not have pre-existing master rental agreement.

However, Applicant notes that there is no evidentiary basis for the Examiner's statement that the "cited reference teach [this] capability and concept of the claimed invention." Instead, as explained in Applicant's Appeal Brief, the evidence of record in this patent application conclusively establishes that the cited references require users to have a pre-existing master rental agreement (MRA) with a rental car company in order to bypass rental contract creation at a rental counter. (See Exhibits 4-7 and pages 18-22 of Applicant's Appeal Brief dated April 16, 2012).

Therefore, because the cited art requires a pre-existing MRA in order for a user to bypass creating a rental contract at a rental counter and because the claim language from claim 62 quoted above cannot reasonably be interpreted as encompassing such a

feature (they are in fact the antithesis of each other), it is elemental that the Examiner has erred in “determining the scope and content of the prior art” and ascertaining the “differences between the prior art and the claims” as required under the *Graham* factors for analyzing the issue of obviousness. Such error mandates reversal of the rejection. The rejection of independent claim 113 must also be reversed for the same reasons.

Further still, the Examiner’s last sentence in the passage quoted above from page 19 of the Examiner’s Answer (“applicant has not positively claimed to limit the use of invention by only the users who do not have a pre-existing master rental agreement”) also demonstrates the erroneous nature of the Examiner’s rejection. First, the issue with respect to claim 62 is whether the computer system taught by the cited art performs the recited steps “regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental facility”, and not whether the user does or does not have a pre-existing MRA. Therefore, because the cited art imposes an MRA requirement on the user’s ability to avoid creating a rental contract at a rental counter while the claimed invention eliminates this requirement, claims 62 and 113 are patentable over the cited art. See American Original Corp. v. Jenkins Food Corp., 696 F.2d 1053, 216 USPQ 945 (4th Cir. 1982) (*affirmed* 774 F.2d 459, 227 USPQ 299 (Fed. Cir. 1985)) (finding that an invention was patentable where the improvement was in the elimination of a requirement found in the prior art). Second, Applicant notes that this statement is also false because dependent claim 139 recites the specific use scenario where the user does not have the pre-existing MRA.

II The Examiner’s Answer Fails to Properly Apply 35 USC 112, Second Paragraph

The Examiner’s Answer rejects claims 62-78, 113-127, 137, and 139 for alleged indefiniteness. In this rejection, the Examiner states at page 6 of the Examiner’s Answer:

In addition, it not clear whether the rental contract is created in the same session when the rental proposal is accepted by the applicant, because claimed invention in dependent claims solicits for additional information from the customer. As it is old and known that contract cannot be changed, but amended, there is a confusion whether the contract as claimed by the applicant is a contract or something else.

However, this statement is not clearly tied to any particular claim which raises confusion regarding whether the indefiniteness rejection under this rationale is applicable to all claims or just some claims. Adding to this confusion is page 17 of the Examiner's Answer which elaborates:

However, claimed invention is patentable under 35 USC 112, second paragraph because, as claimed in Claim 66, there is a disconnected solicitation for information to the reservation is done via email, and applicant has not positively claimed, how the contract is generated in the same reservation session when the amendments to the reservation are done via email.

Applicant interprets this rejection as a rejection of independent claim 62 (and all claims dependent therefrom) based on an allegation that the recitations in claim 66 call into question the definiteness of claim 62.¹ Thus, Applicant further interprets this rejection such that the Examiner is imposing a "same reservation session" requirement on independent claim 62. However, this interpretation of claim 62 constitutes reversible error because it is clear that no such limitation on the scope of claims 62 exists. In fact, the specification is clear that the user is free to choose whether or not to create the electronic rental contract during the same session that he or she creates the rental

¹ Presumably, the Examiner is applying the same rationale to claims 113 and 116.

vehicle reservation. (See, for example, Patent Application at page 12, lines 11-15; page 24, line 22 – page 25, line 3; Figure 6D (buttons 290 and 292)).

As such, claim 66 does not render claim 62 indefinite. An exemplary embodiment encompassed by claim 66 would be where a user has created a rental vehicle reservation but only provided minimal renter information (e.g., name and telephone number). With such an embodiment, it may be the case that the rental car company needs additional renter information to create the electronic rental contract. Upon receipt of the reservation confirmation email recited in claim 66, the user can select a link in that email to access a web page that solicits such additional renter information from the user (e.g., information such as driver's license information, credit card information, etc.) for the purpose of completing an electronic rental contract. Because claim 62 does not place a constraint on the electronic rental contract being created during the same session that the rental vehicle reservation is created, claim 66 does not render claim 62 indefinite. Claim 113 is similarly definite in view of claim 116.

III. The Cited Art Fails to Render Claims 72-73 and 122-123 Obvious

At page 18 of the Examiner's Answer in the "Response to Argument" section, the Examiner alleges:

In response to appellant's argument that cited references do not teach capability and concept of allowing a user to modify or update their information:

However, it is old and known at time of invention that rental car reservations allowed users to update information, and also, cited references teach capability and concept for allowing users to modified their rental information (see Avis, Page 13).

Applicant interprets this comment as applying to claims 72-73 and 122-123 which recite a modifying feature. However, as explained by Applicant at pages 33-36 of the Appeal Brief, claim 72 "describes a method whereby those users who do have pre-existing MRAs can use the information in these MRAs to expedite the reservation creation

process through data pre-filling, but where the user is still free to modify such pre-fills without causing a concomitant modification of the MRA. (See Patent Application at page 17, line 24 – page 18, lines 2; page 17, line 3, lines 16-18; page 31, lines 29-33).” The Examiner’s vague citation to the well-known concept of modifying information is wholly insufficient to support an obviousness rejection of the combination of features recited by claim 72 (as well as claims 73 and 122-123).

IV. Conclusion

Therefore, Appellant respectfully submits that (1) the Examiner’s rejection of the claims must be reversed and (2) the claims are patentable over the cited references because, among other reasons:

- The evidence of record in this patent application conclusively and inescapably demonstrates that the cited art requires a user to have a master rental agreement in order to avoid creating a rental contract at a rental counter when picking up a rental vehicle. This is in direct contrast to the independent claims which recite, inter alia, electronic rental contract creation being performed “regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental facility”.
- The Examiner erred in rejecting the claims for indefiniteness, because claims 62 and 113 are abundantly clear with respect to (1) who may be bound by an MRA to assess claim scope, and (2) that there is not a “same session” requirement with respect to creating the reservation and creating the electronic rental contract.

Thus, for the reasons expressed herein and in Appellant’s Amended Appeal Brief, Appellant respectfully submits that the Examiner’s rejections as to all pending claims in this patent application are in error and must be reversed.

Application No. 09/698,502
Attorney Docket No. 51017-79635

Favorable consideration of this appeal and a speedy allowance is respectfully requested.

Respectfully submitted,

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